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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/489,576	01/21/2000	William J. Baer	STL000013US1	6006

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EXAMINER

NGUYEN BA, PAUL H

ART UNIT PAPER NUMBER

2176

DATE MAILED: 09/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/489,576

Applicant(s)

BAER ET AL.

Examiner

Paul Nguyen-Ba

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 30 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-51 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-51 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 June 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 4/13/2004, etc.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Notice to Applicant*

1. This action is responsive to latest communication: Supplemental Amendment, filed on July 30, 2004.
2. Claims 1-51 are currently pending. Claims 1, 6, 16, 21, 31, and 36 are independent claims.

### *Claim Rejections - 35 USC § 103*

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over McGraw-Hill Primis Custom Publishing ("McGraw") ([www.mhhe.com/primis](http://www.mhhe.com/primis)), archived circa 1998, via the Wayback Machine ([www.archive.org](http://www.archive.org)).

**Independent Claims 1, 6, 11, 16, 21, 31, 36 and****Dependent Claims 4, 11, 19, 26, 34, 41, 49, 50, 51**

McGraw teaches a method, system, and a program storage device readable by a machine for creating custom published textbooks (*compare with* "books") corresponding to the each particular user's needs, teaching technique, style, **content**, and **organization** (see pg. 1).

Primis database (*compare with* "data repository") is a custom publishing database that contains a collection of modular, stand-alone text files (*compare with* "second plurality of content entities of a second hierarchically structured content object") (see pg. 3 → includes textbooks, supplements, journals, magazine articles, lab manuals, case studies, literary works, and historical documents each structured such that the content entities rank or grade in a subordinate manner in a "hierarchy;" see pgs. 5-12 → i.e. discipline, volume, chapter, section, etc.) that can be mixed and matched **in any order** (*compare with* "order selected by a user") and seamlessly arranged to create a custom book (*compare with* "first hierarchically structured content object") consisting of the selected modular text files (*compare with* "first plurality of content entities") (see pg. 3).

Each of the "content entities" of the first and second objects has identifiers (see pgs. 5-9, and 12 → each content identity is identified by a unique title or name, a unique URL, and a unique Item Identifier number).

McGraw does not specifically show defining the first object by a first list of content entity identifiers *organized as an outline of containers such that adding the content entity*

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*identifier of one of the second plurality of content entities to the first list outline adds the identified content entity to the first object.*

However, McGraw teaches an "Add" hyperlink corresponding to each second object identifier (see pgs. 7,9, and 12) for the purpose of adding the content entities of a second object to a first object. McGraw further teaches a "Review" hyperlink for the purpose of reviewing the contents of the first object of the custom publishing process.

It was commonly known to those of ordinary skill in the art that an "Add" hyperlink corresponding to each second object identifier (see pgs. 7,9, and 12) exists for the purpose of adding the content entities of a second object to a first object. It was commonly known to those of ordinary skill in the art that a "Review" hyperlink exists for the purpose of reviewing the contents of the first object in an outline form, showing the structure of "containers" wherein each content entity ranks or grades, with each level subordinate to the one above (for example, see "Microsoft Powerpoint Presentation on how to use Primis Online," (pgs. 6 and 9) cited below).

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to utilize an "Add" hyperlink corresponding to each second object identifier (see pgs. 7,9, and 12) for the purpose of adding the content entities of a second object to a first object. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to utilize a "Review" hyperlink exists for the purpose of reviewing the contents of the first object in an outline form, showing the structure of "containers" wherein each content entity ranks or grades, with each level subordinate to the one above

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**Claims 2, 7, 17, 22, 32, 37**

McGraw further teaches *defining the second object by a second outline of containers* (pgs. 3, 7, 9, and 12 → the available textbooks are defined in hierarchical outline form (collection of modular text files that can be mixed and matched) → book containers, chapter containers, etc.) or *list of content entity identifiers* (see pgs. 5-9, and 12 → each content identity is identified by a unique title or name, a unique URL, and a unique Item Identifier number).

**Claims 3, 8, 18, 23, 33, 38**

McGraw further teaches the method, system, and a program storage device readable by a machine wherein *adding an entity identifier from the second list or second outline container to the first list adds the identified content entity to the first object* (pgs. 7, 9, 12 → the “Add” hyperlink adds the second list or outline to the customized textbook, as discussed above).

**Claims 5, 13, 14, 20, 28, 29, 35, 43, 44**

McGraw further teaches a *user interface communicating with the data repository* (pgs. 5-12 → i.e. Website browser communicating with Primis database), and *providing a mechanism for selecting a content entity identifier or a container from the second list or second outline to add to a desired location in the first list through the user interface* (pgs. 7, 9, 12 → the “Add” hyperlink adds the second list or outline to a specified location in the customized textbook, as discussed above).

**Claims 9, 24, 39**

McGraw further teaches the method, system, and a program storage device readable by a machine wherein *a first container in the second outline contains on or more containers* (pgs. 3,

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5-12 → “disciplines container” contains “book containers” which further contains “chapter containers” which further contain “section containers,” etc.).

**Claims 12, 27, 42**

McGraw further teaches the method, system, and a program storage device readable by a machine wherein *the first and second objects are books* (pgs. 6, 8, 10) and the *containers are one or more of a book, volume, and a chapter* (pgs 7, 9, 12).

**Claims 15, 30, 45**

McGraw further teaches *a user interface communicating with the data repository*, and *providing a mechanism for creating a new container to add to the first outline at a desired location through the user interface* (pg. 3 → allows instructors to add their own created syllabus to the first outline at a desired location by uploading it through the user interface).

**Claims 10, 25, 40**

McGraw teaches a method, system, and a program storage device readable by a machine as explained with respect to claims 6, 7, and 9 above, but does not specifically teach the method, system, and the program storage device readable by a machine wherein adding the first container to the first outline adds the content entities identified by the content entity identifiers of *all containers* in the first container to the first object.

McGraw teaches the outlining of textbooks into containers for the purpose of increasing the modularity of files for ease in creating a mixed and matched customized book (pgs. 3, 7, 9, 12).

It was commonly known to those of ordinary skill in the art that in hierarchical outlines each level is subordinate to the one above. Therefore, it would have been obvious at the time the



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invention was made to a person having ordinary skill in the art to modify the teachings of McGraw to add the content entities identified, as well as all of the content entities' dependents (i.e. full containers), in the first container object for the purpose of increasing the modularity of files for ease in creating a mixed and matched customized book.

#### **Claims 46-48**

McGraw teaches the method, program storage device, and system wherein said first list of content identity identifiers defining the first object comprises content identity identifier names (see pgs. 5-9, and 12 → each content identity is identified by a unique title or name, a unique URL, and a unique Item Identifier number), but does not specifically teach the content identity identifier names being defined by the user.

However, McGraw teaches the compilation of a custom textbook using the instructor's own content and materials (see pgs. 1 and 3 – 2<sup>nd</sup> paragraph) for the purpose of customizing the textbook to the instructor's own personal preferences. It was commonly known to those of ordinary skill in the art that an instructor can define his own work's content entity identifier for the purpose of customizing the final textbook to the instructor's own personal preferences.

Therefore, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to allow an instructor to define his own work's content entity identifier for the purpose of customizing the final textbook to the instructor's own personal preferences.

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***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US 6091930 A	20000718	MILLER, M E et al.
US 20030050916 A	20030313	BORTSCHELLER, L E et al.
US 20030140315 A	20030724	BLUMBERG, R E et al.

Microsoft Powerpoint Presentation on how to use Primis Online

(<http://www.mhhe.com/primis/catalog/pcatalog/phmisweb.ppt>).


6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Nguyen-Ba whose telephone number is (703) 305-8776.

The examiner can normally be reached from 10:30 am - 7:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Feild can be reached on (703) 305-9792. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PNB

  
SANJIV SHAH  
PRIMARY EXAMINER